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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/200,055	11/25/98	GARIBALDI J	3176-7694

QM32/1004

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EXAMINER	
THOMPSON, M	
ART UNIT	**PAPER NUMBER**
3763	8

DATE MAILED: 10/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/200,055	Garibaldi et al.
Examiner	**Group Art Unit**
Michael M. Thompson	3763

☒ Responsive to communication(s) filed on *Jun 29, 2000*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-40* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1, 2, 4-8, 10-14, 16-25, 27-32, and 34-40* is/are rejected.

☒ Claim(s) *3, 9, 15, 26, and 33* is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 U.S.C. § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 2, 4-8, 10-14, 16-25, 27-32, and 34-40 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Werp et al ('818). Werp et al ('818) teaches an medical device including a stylet or guide device maintaining a greater length than the tubular member and a magnetic means attached to the distal end of the

stylet. The method is taught to utilize a second magnetic means for external placement over the orifice of the patient. The device is inherently pushed at the proximate end and pulled via magnetic force at the distal end. The magnetic material is inherently flexible with regard to other materials.

5. In the alternative, Werp et al ('818) teaches the device as disclosed but does not get specific as to the "magnetic means" or the materials utilized. It is well settled in the art that one magnet may replace many magnets, or vice versa. It is also well settled in the art that "magnetic means" is interpreted as inherently disclosing both permeable or non-permeable substances so long as the material utilized displays magnetic properties. It is the Examiner's position that Werp et al ('818) renders obvious if not inherent Applicant's invention and methods in light of the reasons mentioned above, and include all of the limitations herein. For the purpose of understanding the Examiner's position on magnets, the following is a basis for understanding magnets and their properties. It was suggested in 1907 that a ferromagnetic material is composed of a large number of small volumes called domains, each of which is magnetized to saturation. In 1931 the existence of such domains was first demonstrated by direct experiment. The ferromagnetic body as a whole appears unmagnetized when the directions of the individual domain magnetizations are distributed at random. Each domain is separated from its neighbors by a domain wall. In the wall region, the direction of magnetization turns from that of one domain to that of its neighbor. The process of magnetization of magnetized materials, starting from a perfect unmagnetized state, comprises three stages: (1) Low magnetizing field. Reversible movements of

the domain walls occur such that domains oriented in the general direction of the magnetizing field grow at the expense of those unfavorably oriented; the walls return to their original position on removal of the magnetizing field, and there is no remanent magnetization. (2) Medium magnetizing field. Larger movements of domain walls occur, many of which are irreversible, and the volume of favorably oriented domains is much increased. On removal of the field, all the walls do not return to their original positions, and there is a remanent magnetization. (3) High magnetizing field. Large movements of domain walls occur such that many are swept out of the specimen completely. The directions of magnetization in the remaining domains gradually rotate, as the field is increased, until the magnetization is everywhere parallel to the field and the material is magnetized to saturation. On removal of the field, domain walls reappear and the domain magnetizations may rotate away from the original field direction. The remanent magnetization has its maximum value. A permanent magnet can be visualized as the result of assembling the magnet from a large number of particles having a high value of saturation magnetization, each of which is a single domain, each having a uniaxial anisotropy in the desired direction, and each aligned with its magnetization parallel to all the others. Furthermore, with respect to permeable magnetic material, it is well known in the art that materials allowing magnetic lines of force to pass through them are called nonpermeable, and materials that gather magnetic lines of force are said to be permeable. This is because metal acts as a magnetic shield because the force lines come from the pole of the magnet and do not pass through the metal material. Instead, they are gathered in, travel down the metal material, and re-enters the magnet at the other pole. Therefore,

only magnetic materials are permeable. Furthermore, with respect to permeable magnetic material, it is well known in the art that materials allowing magnetic lines of force to pass through them are called nonpermeable, and materials that gather magnetic lines of force are said to be permeable. This is because metal acts as a magnetic shield because the force lines come from the pole of the magnet and do not pass through the metal material. Instead, they are gathered in, travel down the metal material, and re-enters the magnet at the other pole. Therefore, only magnetic materials are permeable. Therefore it is further obvious to one of ordinary skill in the art at the time of invention to make such a design modification at the device level as the applicant has taught that such merely a design modification. Please note that since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art, claims to multiple magnets have been rejected supra.

6. Claims 4, 10, 16, 27, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werp et al ('818) in view of Viera ('023). Werp et al ('818) teaches the device substantially as claimed however fails to point out the "magnetic means" as more than one magnet, or multiple annular magnets radially spaced apart as specified. Viera teaches such a magnet utilized in the same art. It is well settled that "magnetic means" incorporates any structure displaying magnetic field and forces. Clearly it would have been obvious to one of ordinary skill in the art at the time of invention to make or use the device of Anderson with the magnetic means of Viera for the purposes of creating a region of increased angularity. Please note that the purposes of the Viera magnets or intended use are irrelevant when interpreting Applicant's structural limitations.

Allowable Subject Matter

7. Claims 3, 9, 15, 26, and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thompson whose telephone number is (703) 305-1619. The examiner can normally be reached on Monday- Thursday from 9am to 6pm. The examiner can also be reached on alternate Fridays.

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

Michael Thompson MT
20 September 2000

RICHARD SCHILLER
SPE 3763